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PATENT

#11  
B. Webb  
9/20/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Lee, *et al.*

Application No: 09/824,625

Filing Date: April 2, 2001

Entitled: **METHODS AND APPARATUS  
FOR THERMALLY AFFECTING  
TISSUE**

Atty. Docket No: 22727-66

Group Art Unit: 3739

Examiner: K. Schopfer

Certificate of Mailing (37 C.F.R. 1.8(a))

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8-30-02

Date of Signature and Mail Deposit

By:

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William C. Geary III, Reg. No. 31,359  
Attorney for Applicant(s)

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents  
Washington, DC 20231

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SEP 13 2002

Dear Sir:

TECHNOLOGY CENTER R3700

This communication is in response to the Office Action dated May 31, 2002 requiring restriction of the above-referenced application to one of the following groups of claims:

- I. Claims 1-19, drawn to an apparatus for thermally affecting tissue, classified in class 607, subclass 113;
- II. Claims 20-28, drawn to another apparatus for thermally affecting tissue, classified in class 607, subclass 113;
- III. Claims 29-33, drawn to a method for thermally affecting tissue, classified in class 607, subclass 113;

- IV. Claim 34, drawn to a method of cooling brain tissue, classified in class 607, subclass 113;
- V. Claims 35-40, drawn to another method of cooling brain tissue, classified in class 607, subclass 113;
- VI. Claims 41-43, drawn to an apparatus for cooling brain tissue, classified in class 607, subclass 113;
- VII. Claim 44, drawn to a method of thermally affecting cranial tissue, classified in class 607, subclass 113; and
- VIII. Claim 45, drawn to a method of cooling brain tissue, classified in class 607, subclass 113.

Applicants elect, with traverse, the Group I claims (claims 1-19) drawn to an apparatus for thermally affecting tissue. Applicants hereby reserve the right to prosecute the non-elected claims in a divisional or other application. According to the Examiner's restriction requirement, the recited groups represent eight distinct inventions. Applicant respectfully submits that the pending claims of the present invention recite related inventions. For example, each of these groups has been classified in the same class and subclass, *i.e.* class 607, subclass 113. Moreover, a single search should suffice for examination all of pending claims in the present invention, without being too burdensome on the Examiner. Finally, the Examiner has failed to show that even though the inventions are classified together, each subject has formed "a separate status in the art." *See* M.P.E.P. § 808.02. "Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, *no reasons exist for dividing among related applications.*" *See id.* (emphasis added). Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the restriction requirement.

In the Office Action dated May 31, 2002, the Examiner also required an election between six patentably distinct species identified by the Examiner: a first species seen in Figures 1, 2, 4 and 6-8; a second species seen in Figure 3; a third species seen in Figures 9-11; a fourth species


seen in Figures 12-14; a fifth species seen in Figure 15; and a sixth species seen in Figures 16A and 16B.

Applicants hereby elect, with traverse, the first species seen in Figures 1, 2, 4 and 6-8. Claims 1-19 read on the elected species. Claim 1 is a generic claim that reads on the embodiments depicted in Figures 1-4 and 6-11, which correspond to the first, second and third species. Claim 1 is silent with regard to the particular characteristics of the implantable member, such as, for example, the composition, size, and shape of the implantable member and the fluid-tight lumen therein. Therefore, claim 1 clearly reads on embodiments having a coiled implantable member and a fluid-tight lumen with uniform or variable width, as shown in Figures 2-4 and 6-8, and on embodiments having an implantable member constructed from, or containing, a shape memory material, as shown in Figures 9-11.

In light of the foregoing remarks, Applicants respectfully request that the Examiner reconsider and withdraw the restriction and election requirements. The Examiner is urged to telephone the undersigned Attorney for Applicant(s) in the event that such communication is deemed to expedite prosecution of this matter.

Respectfully submitted,

Date: 8-30-02

  
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